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EXAMINER

CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/890,076

Applicant(s)

LUO ET AL.

Examiner

Dohm Chankong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 and 25-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 and 25-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- 1> This action is in response to Applicant's request for continued examination. Claims 22, 39 and 46 are amended. Claims 22 and 25-60 are presented for further examination.
- 2> This is a non-final rejection.

Continued Examination Under 37 CFR 1.114

- 3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10.13.2006 has been entered.

Response to Arguments

- 4> Applicant's principal argument against the Beck reference is that Beck fails to teach the new limitation whereby code is downloaded to generate commands for controlling a set of services. Applicant asserts that Beck's reliance on method calls to control services is not analogous. For the following reasons, the Office disagrees.

In interpreting the new limitation, the Office is guided by Applicant's specification. The instant specification, at pages 12-15, seem to describe the new limitations; the specification describes that for a PowerPoint service, a user may can control PowerPoint with the ability to add comments or add scribbled graphics to the slide. To effectuate this

control scheme, the specification further details utilizing a PowerPoint control class which consists of a variety of methods, including the method of "AddComments" and "AddScribble". Similarly, Beck discloses using a service by calling the methods that the service provides [Figure 6 | column 6 «lines 30-33»]. It is clear from Beck's disclosure that the methods called by the client control the service [Figure 6 "Service implementation performs the call"]. Beck's use of methods is therefore analogous to Applicant's use of methods to control services. Therefore, Beck's methods are analogous to commands as claimed.

5> Applicant's remarks with respect to the use of an Official Notice for the rejection of claims 26, 28-30, 32-34 and 38 are not persuasive. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

Applicant asserts that Applicant's "did in fact rebut the essence" of the conclusions set forth in the Official Notice. This is not the proper form for traversing the use of an Official Notice and is not analogous to specifically pointing out the supposed errors are not considered to be common knowledge. In fact, the proper form was utilized by Applicant in challenging the rejection of claims 39, 42, 44 and 45. See Applicant's remarks (filed 3.20.2006), pg. 10.

With respect to the rejection of claims 26, 28-30, 32-34 and 38 in Applicant's remarks, Applicant did not even discuss or acknowledge the use of the Official Notice. Therefore, there is even no support for Applicant's supposed rebuttal of the essence of the Official

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Notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice.

6> Applicant's remarks with respect to the §103 rejections are moot in view of the new grounds of rejections set forth in this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7> Claim 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The term "palm-sized" does not clearly and distinctly describe the size of the portable computing platform.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international

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application designated the United States and was published under Article 21(2) of such treaty in the English language.

8> Claims 22, 25, 28-30, 35, 39, 42 and 45 are rejected under 35 U.S.C § 102(e) as being anticipated by Beck et al, U.S Patent No. 6,604,140 ["Beck"].

9> As to claim 22, Beck discloses a data processing tool for controlling an application accessible via a network, comprising:

a console application including a user interface program [column 4 «lines 10-30»], information about services, including network addresses, in a group of services accessible via the network [column 1 «lines 60-62» | column 4 «lines 10-30 and 45-54»], and a communication driver executing a protocol for communication of the console application with at least one of the services in the group, wherein the protocol includes code to perform one or more exchanges in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked, and by which the console application learns the network addresses of services in the group [column 2 «lines 47-63» | column 3 «lines 38-41» | column 4 «lines 10-60» | column 7 «lines 45-62»];

an input/output device supporting the user interface program, wherein the device includes code that, in accordance with the notification of the set of services, downloads code to generate commands for controlling the set of services [column 6 «lines 12-31»]; and

a communication port by which access to the network is available [column 7 «lines 45-48»].

10> As to claim 25, Beck discloses the an exchange in which a particular service in the group of services sends the console application a set of user interface constructs for incorporation in the user interface program [column 4 «lines 10-30» | column 5 «lines 42-46» | column 6 «lines 12-16»].

11> As to claim 28, Beck discloses services including a calendar program [column 8 «lines 49-56»].

12> As to claims 29 and 30, Beck discloses a user interface program for a networked appliance and a print services [column 7 «lines 18-25»].

13> As to claim 35, Beck discloses a port comprising a wireless transmitter and receiver [column 4 «lines 3-9» | column 7 «lines 45-48»].

14> As to claim 39, Beck discloses a method for controlling an application executable on a particular processor coupled to a network using a portable computing platform, comprising:
establishing a communication link via the network between the portable computing platform and the particular processor, wherein establishing the communication link includes notifying the processor that the processor will act as an application host for a group of services and by which the portable computing platform learns the network addresses of services in the group [column 3 «lines 48-58» | claims 1, 14, 19 and 20];

transferring a control program to the portable computing platform via the network, the control program including user interface constructs for generating commands for control of the application [column 5 «lines 38-64» | column 6 «lines 12-44»];

transmitting commands input using the control program to the particular processor via the communication link [column 6 «lines 30-44» | column 7 «lines 32-44»];

transferring the commands input using the control program to the application [column 6 «lines 30-44» | column 7 «lines 32-44»].

15> As to claim 42, Beck discloses a wireless link [column 4 «lines 3-9»].

16> As to claim 45, Beck discloses a portable computing platform that is palm sized [column 3 «lines 48-49»].

17> Claims 22, 25, 27-29, 31, 32, 46, 47, 49-51, 53 and 54 are rejected under 35 U.S.C §102(e) as being anticipated by Riggins et al, U.S Patent No. 6,131,116 [“Riggins”].

18> As to claim 22, Riggins discloses a data processing tool for controlling an application accessible via a network, comprising:

a console application including a user interface program [column 1 «lines 49-53»], information about services, including network addresses, in a group of services accessible via the network [column 3 «lines 30-40» : “service addresses”], and a communication driver executing a protocol for communication of the console application with at least one of the

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services in the group, wherein the protocol includes code to perform one or more exchanges in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked, and by which the console application learns the network addresses of services in the group [column 3 «lines 30-40 and 49-67» | column 5 «lines 51-57» where : the master server is analogous to an application host];

an input/output device supporting the user interface program, wherein the device includes code that, in accordance with the notification of the set of services, downloads code to generate commands for controlling the set of services [column 3 «lines 8-15 and 49-68» | column 4 «lines 19-33» | column 7 «lines 17-25» : Riggins' applets used to control the service, and forwarding instructions to control said service. Riggins instructions are analogous to commands]; and

a communication port by which access to the network is available [Figure 2 «items 140, 250»].

19> As to claim 25, Riggins discloses the protocol includes an exchange in which a particular service in the group of services sends the console application a set of user interface constructs for incorporation in the user interface program [column 4 «line 64» to column 5 «line 4» | column 5 «lines 39-50» | column 7 «lines 26-35» : utilizing configuration data to customize the interface with respect to the font, window size, text size, etc. Each service has its own applet that is used to control user interface I/O. Each applet has its own applet-specific configuration information for the service including interface parameters].

20> As to claims 27-29, 31, 32, 49-51, 53 and 54, Riggins discloses services including: an email client, a calendar program, a user interface program for a networked appliance, a fax service and an internet browsing service [Figure 5].

21> As to claim 46, Riggins discloses a data processing tool for controlling an application accessible via a network, comprising:

a console application including a user interface program [column 1 «lines 49-53»], information about services, including network addresses, in a group of services accessible via the network [column 3 «lines 30-40»: “service addresses”], and a communication driver executing a protocol for communication of the console application with at least one of the services in the group, wherein the protocol includes code to perform one or more exchanges in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked, and the particular service in the group of services sends the console application a set of user interface constructs for incorporation in the user interface program [column 1 «lines 49-53» | column 2 «lines 2-7» | column 4 «line 64» to column 5 «line 4» | column 5 «lines 39-57» | column 7 «lines 1-25»]; the configuration data modifies the GUI to incorporate fonts, window size, text size, etc. Each service has its own applet that is used to control user interface I/O. Each applet has its own applet-specific configuration information for the service including interface parameters];

an input/output device supporting the user interface program, wherein the device includes code that, in accordance with the notification of the set of services, downloads code to generate commands for controlling the set of services [column 3 «lines 8-15 and 49-68» |

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column 4 «lines 19-33» | column 7 «lines 17-25» : Riggins' applets used to control the service, and forwarding instructions to control said service. Riggins instructions are analogous to commands]; and

a communication port by which access to the network is available [Figure 2 «items 140, 250»].

22> As to claim 47, Riggins discloses learning network addresses of services in the group [column 5 «lines 55-57»].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23> Claims 26, 30, 33, 34, 48, 52, 55 and 56 are rejected under 35 U.S.C § 103(a) as being unpatentable over Riggins, in further view of admitted prior art.

24> As to claims 26, 30, 33 and 34, Riggins discloses the use of network services for various purposes [column 5 «lines 51-57»], but does not specifically disclose slide presentation service, a print service, a speech translation service or a conference room reservation service, as claimed. As noted, Applicant failed to properly traverse the use of the Official Notice as set

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forth in the non-final rejection, filed 12.22.2005. As such, the well known in the art statement is taken to be admitted prior art.

Services such as a slide presentation, print services, speech translation and room reservation function are well known in the art and not patentably distinct as they are merely fields of use. Therefore, Official Notice is taken that one of ordinary skill in the art would have reasonably implemented the aforementioned services into Riggins to provide a greater range of functionality of services available to the user. Merely implementing different services, such as a slide presentation program, as opposed to the services specifically discussed in Riggins does not patentably distinguish the instant application over Riggins.

25> Claims 35, 36, 39, 42, 43, 57 and 58 is rejected under 35 U.S.C § 103(a) as being unpatentable over Riggins, in further view of Whitehead et al, U.S Patent No. 6,085,030 ["Whitehead"].

26> As to claims 35, 36, 42, 43, 57 and 58, Riggins does not disclose a wireless link or an infrared transmitter and receiver.

27> Whitehead discloses a communication link comprising an wireless link (infrared link), and that its use is well known in the art [column 6 «lines 20-25» : infrared receiver and transmitter implied by the use of infrared wireless]. Therefore, it would have been obvious to one of ordinary skill to have reasonably implemented Whitehead's wireless and infrared links into Riggins' networking system. Such a combination would improve Riggins' ability to

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provide network services to a roaming user such that the roaming user would be enabled to use wireless computers to access the services.

28> As to claim 39, Riggins discloses a method for controlling an application executable on a particular processor coupled to a network using a computing platform, comprising:

establishing a communication link via the network between the computing platform and the particular processor, wherein establishing the communication link includes notifying the processor that the processor will act as an application host for a group of services and by which the computing platform learns the network addresses of services in the group [Figure 1 | column 3 «lines 15-40» where : the master server is the application host, the remote client downloads configuration data including service addresses];

transferring a control program to the computing platform via the network, the control program including user interface constructs for generating commands for control of the application [column 3 «lines 8-15 and 49-68» | column 4 «lines 19-33» | column 7 «lines 17-25» : Riggins' applets used to control the service, and forwarding instructions to control said service. Riggins instructions are analogous to command];

transmitting commands input using the control program to the particular processor via the communication link [column 7 «lines 45-59»];

transferring the commands input using the control program to the application [column 7 «lines 13-25 and 45-59»].

Riggins does not expressly disclose that the computing platform is portable.

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29> In the same field of invention, Whitehead discloses a variety of computing nodes that can remotely control services over a distributed network [column 4 «lines 36-53»].

Whitehead discloses that the computing nodes can be implemented in a portable device [column 6 «lines 15-25»]. It would have been obvious to one of ordinary skill to have reasonably implemented Whitehead's portable computing devices into Riggins' networking system. Such a combination would improve Riggins' ability to provide network services to a roaming user such that the roaming user would be enabled to use wireless computers to access the services.

30> Claims 37, 38, 44 and 45 are rejected under 35 U.S.C §103(a) as being unpatentable over Beck in view of an Official Notice.

31> As to claim 37, Beck discloses utilizing mobile devices but does disclose a touch screen. Official Notice is taken that it is well known in the art that a majority of mobile devices such as those described in Beck comprise touch screens, such as PDAs. Therefore, it would have been obvious to one of ordinary skill in the art to have reasonably inferred that Beck's mobile devices would have included touch screens as they ubiquitous and well known in the art.

32> As to claims 38 and 44, Official Notice was taken in the non-final rejection, filed 12.22.2005. As noted, Applicant did not properly traverse this Official Notice and therefore, this well known in the art statement is taken to be admitted prior art. Therefore, it would

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have been obvious to one of ordinary skill in the art to implement the size restrictions of 4 inches by 6 inches or smaller on the handheld device to keep the size of the device within the limits of portability. Furthermore, it is simply a matter of design choice that dictates the size of a screen and does not patentably distinguish over the prior art.

33> Claims 40 and 41 are rejected under 35 U.S.C § 103(a) as being unpatentable over Riggins and Whitehead, in further view of Myers et al, "Collaboration Using Multiple PDAs connected to a PC" ["Myers"].

34> As to claim 40, Riggins does disclose remote execution of computer programs over a network but does not explicitly disclose a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for opening a presentation for display on a display coupled to the network, under control of the particular processor, and navigating slides within the presentation.

35> Myers discloses a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for opening a presentation for display on a display coupled to the network, under control of the particular processor, and navigating slides within the presentation [page 6 «section titled "PowerPoint Version"»]. It would have been obvious to one of ordinary skill in the art to have reasonably inferred and implemented a slide presentation application into Riggins'

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remote control method as taught by Myers. One would have been motivated to perform the implementation in Riggins to allow users access to existing applications such as PowerPoint.

36> As to claim 41, Riggins does disclose remote execution of computer programs over a network but does not explicitly disclose a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for editing slides within the presentation.

37> Myers discloses a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for editing slides within the presentation. [page 6 «section titled "PowerPoint Version"»]. It would have been obvious to one of ordinary skill in the art to have reasonably inferred and implemented a slide presentation application into Riggins remote control method as taught by Myers. One would have been motivated to perform the implementation in Riggins to allow users to control existing applications such as PowerPoint.

38> Claims 59 and 60 are rejected under 35 U.S.C §103(a) as being unpatentable over Riggins, in view of Whitehead, in further view of an Official Notice.

39> As to claim 59, Riggins does not disclose a touch screen. Whitehead discloses a variety of computing nodes that can remotely control services over a distributed network [column 4 «lines 36-53»]. Whitehead discloses that the computing nodes can be implemented in a

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portable device [column 6 «lines 15-25»]. It would have been obvious to one of ordinary skill to have reasonably implemented Whitehead's portable computing devices into Riggins' networking system. Such a combination would improve Riggins' ability to provide network services to a roaming user such that the roaming user would be enabled to use wireless computers to access the services.

Official Notice is taken that it is well known in the art that a majority of mobile devices such as those described in Whitehead comprise touch screens, such as PDAs. Therefore, it would have been obvious to one of ordinary skill in the art to have reasonably inferred that Riggins' and Whitehead's mobile devices would have included touch screens as they ubiquitous and well known in the art.

40> As to claim 60, Riggins and Whitehead does not disclose a screen smaller than 4 inches by 6 inches in display area. Official Notice was taken in the non-final rejection, filed 12.22.2005. As noted, Applicant did not properly traverse this Official Notice and therefore this well known in the art statement is taken to be admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art to implement the size restrictions of 4 inches by 6 inches or smaller on the handheld device to keep the size of the device within the limits of portability. Furthermore, it is simply a matter of design choice that dictates the size of a screen and does not patentably distinguish over the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

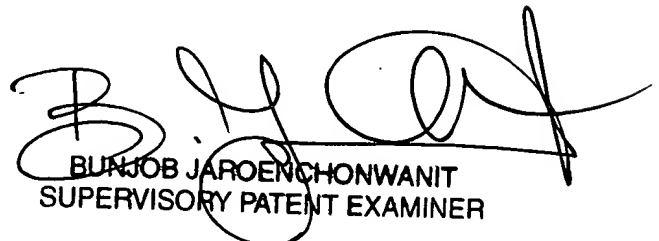
Stern et al, U.S Patent No. 5,935,249.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Tuesday-Friday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC


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SUPERVISORY PATENT EXAMINER